

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Gregory Kelly

Confirmation No.: 1753

Serial No.: 10/542,399

Examiner: Sarah Purol

Filing Date: July 14, 2005

Art Unit: 3634

For: Truncated pyramidal golf ball positioning device

Customer No: 63704

BOX AF NO FEE

Commissioner for Patents

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**PETITION FOR WITHDRAWAL OF REQUIREMENT FOR RESTRICTION
AND WITHDRAWAL OF FINALITY DESIGNATION**

Applicant petitions that the restriction requirement and finality designation in the Office Action dated January 16, 2008 be withdrawn.

Remarks/Arguments begin on page 2 of this paper.

Claims 1-19 are withdrawn. No claims are under examination on the merits as a result of the restriction requirement. A Response filed January 18, 2008 requested that the restriction requirement and finality designation be withdrawn. It was requested that that this petition be granted to compel the withdrawal of the restriction requirement and the finality designation of the Office Action, as well as to compel a showing that the arguments raised in the non entered Office Action dated October 10, 2007 were considered on the merits.

I. RESTRICTION – IMPROPERLY IMPOSED

Restriction was imposed on the claims 1-19 based on the following rationale:

Amended claims 1-19 are withdrawn from further examination on the basis that claiming the golf balls in combination with the hopper and tray is an invention within the prevue of class 206 and not class 211. The inventions are considered distinct and independent from the device originally claimed.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-19 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The rationale is not in compliance with MPEP 808.02, which requires that the inventions as claimed be shown to be independent or distinct under the criteria of MPEP § 806.05 - § 806.06, as well as be given an explanation as to why there would be a serious burden on the examiner if restriction is not required.

While the office action attempts to provide the explanation as to why there would be a serious burden on the examiner if restriction is not required, such an explanation by itself is inadequate. The Examiner's burden is not met unless there is also a showing that the inventions are independent or distinct under the criteria of MPEP § 806.05 - § 806.06. No effort was made in the Office to establish that such criteria is satisfied in this case and thus the withdrawal of claims 1-19 from further examination was improper.

Any resort to establishing satisfaction of the criteria of MPEP § 806.05 - § 806.06 would lead one to MPEP § 806.05 (I.) SUBCOMBINATION ESSENTIAL TO COMBINATION, which provides that

Where a combination *as claimed* requires the details of a subcombination *as separately claimed*, there is usually no evidence that combination AB^{sp} is patentable without the details of B^{sp}. The inventions are not distinct and a requirement for restriction must not be made or maintained, even if the subcombination has separate utility.

The original pending claims recite a hopper and tray, which are essential to the combination of the hopper, tray and stacked golf balls of the now pending claims.

Further, the proffered explanation in the Office Action that relies upon different classes 206 and 211 appears specious. Without question, class 211 is an improper classification for the originally claimed invention that recited a hopper and tray as the golf ball positioning device. According to the 211 class definition in the Classification Manual:

Class 211 includes

“built-up open framework structures designed to support articles. Racks in the nature of upright stands or standards carrying article supports are also included, and also self-supporting articles supports, frequently built up of sheet material.”

Original independent claim 1 recited a hopper and tray, which are not analogous to “built-up open framework structures”, “racks”, “upright stands”, “standards carrying article supports”, “self-supporting articles supports”, or “built-up of sheet material”.

When not a single item in a class definition matches the recited claim elements, such should put one on notice that the selected class is inappropriate for classifying that claimed invention. Such a comparison should lead one to look to other class definitions, such as class 206, whose definition (a) calling for a container is indicative of the hopper and tray assembly of original claim 1 that is to hold golf balls. According to the 206 class definition in the Classification Manual:

Class 206 is the residual locus for: (a) a container configured to hold a particular article or set of articles or material; (b) a mercantile unit - i.e., means in or by which goods (article or material) are displayed, protected, packaged or arranged in a particular manner, to facilitate sale, transportation in commerce, use or storage or (c) a packet, compact or case carried on the person of a user.

(1) Note. Containers of this class type must function, by disclosure, to hold contents, which in turn are to be eventually removed from the container.

(4) Note. Generally, unless provided for in some other class as partially indicated under "SEARCH CLASS" below, the combination of an article (or material) and its containment means is to be found in this (206) class. However, the claimed disclosure of content is ordinarily not a basis for intra class distinctions among the subclasses therein.

(7) Note. Included here is a container wherein the content (article or material) included, or to be included therein, bears some relationship to the container other than mere containment.

Therefore, the applicant should not be denied examination of claims on the basis of a clear misclassification of the invention by the USPTO that apparently erroneously assigned class 206 to the original claims instead of the appropriate class 211.

II. FINALITY DESIGNATION – IMPROPERLY IMPOSED

Further, the Office Action is not properly made final under MPEP 706.07(b), which provides:

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

According to the Office Action, claims 1-19 are withdrawn for being directed to a non-elected species of invention. According to such a finding, the subject matter of the present claims could not satisfy (B)(1) of MPEP 706.07(b) that calls for all the claims to be drawn to the same invention claimed in the earlier application, which is a requirement that must be satisfied to warrant finality of the claim rejection in the first Office Action. Further, the requirement of (B)(2) is not met since there has not been any examination on the merits for the pending claims. As a result, the Examiner was unaware as to whether the pending claims would have been properly finally rejected on the grounds and art of record if they had been entered in the earlier application.

Serial No. 10/542,399

Office Action dated January 16, 2008

Petition for withdrawal of restriction and finality dated February 6, 2008

Page 6

Therefore, the rendering of a finality designation was improper and warrants withdrawal.

III. INCOMPLETE OFFICE ACTION

The Office Action dated January 16, 2008 is incomplete. It merely withdraws all claims without responding to the arguments raised in the now entered amendment of October 10, 2007. An Advisory Action dated October 29, 2007 opted not to enter the amendment and provided no substantive explanation for doing so. No retort to the arguments raised in the Office Action dated October 10, 2007 was ever provided, It is requested that such arguments be considered by the Examiner and that a substantive response to them be provided that compares the subject matter of each claim individually with the prior art.

Respectfully submitted,

A handwritten signature in cursive script that reads "Robert Hess". The signature is written in dark ink and is positioned above the printed name and contact information.

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